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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Aliberto	)	Art Unit: 3763
Serial No.:	10/057,334	)	Examiner: Thissell
Filed:	January 23, 2002	)	**001/062USA**
For:	CENTRAL VENOUS CATHETER WITH HEAT EXCHANGE MEMBRANE	)	August 4, 2004 750 B STREET, Suite 3120 San Diego, CA 92101

REQUEST FOR REHEARING UNDER 37 C.F.R. §1.197

Commissioner of Patents and Trademarks
Washington, DC 20231

Dear Sir:

Rehearing is respectfully requested because Appellant believes that the Board, in its decision dated July 27, 2004, misapprehended points of law. Specifically, with respect to Claim 5 the Board levied various allegations about Appellant's own specification in rebutting Appellant's observation that no prior art suggestion exists to combine Clifton with Ginsburg. What is set forth in Appellant's specification is, of course irrelevant to the question of where the ***prior art*** provides the requisite suggestion to combine, and Appellant believes that therein lies reversible legal error.

With more specificity, Appellant respectfully believes that reversible legal error has arisen due to the failure on the part of the Board and the examiner to explain their belief that Ginsburg is properly combinable with Clifton despite the fact that Clifton expressly requires profound hypothermia and when Ginsburg explicitly states that its intended use is to induce levels of

hypothermia that are much less severe than profound hypothermia. This point has been studiously ignored, as it must be to sustain the rejection.

The Board's sole observation about Appellant's well-grounded argument above is that "Applicant's claimed methods are not limited, and do not distinguish between, degrees of cooling". Whether correct or not, this observation is irrelevant. Appellant's specification is not part of the prior art. It bears no materiality on the question of the prior art suggestion to combine. Either the prior art suggests a combination or it doesn't, regardless of what a patent applicant later writes in a patent specification.

The evidence of record clearly demonstrates the as-yet uncontradicted fact that Clifton contemplates a level of hypothermia which Ginsburg expressly teaches that it does not intend to achieve, thus depriving the *prima facie* case of legal legitimacy. When evidence of record is ignored and instead broad conclusory statements are substituted therefor, reversible legal error has occurred ("the range of sources available does not diminish the requirement for **actual evidence**, and broad conclusory statements regarding the teaching of multiple references, standing alone, are not evidence", In re Dembiczak, 175 F.3D 994, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999)). As set forth in Dembiczak, "the best defense against the subtle but powerful attraction of hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references", Id. at 999, 50 U.S.P.Q.2d at 1617. It should be axiomatic that the requirement of Dembiczak cannot be met by reference to an applicant's own specification.

Respectfully submitted,

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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TRANSMITTAL LETTER FOR REQUEST FOR REHEARING UNDER 37 C.F.R. §1.197

Commissioner for Patents
Alexandria, VA 22313

Dear Sir:

Enclosed herewith are the following:

1. Request for Rehearing in 3 pages;

2. Acknowledgment postcard.

Respectfully submitted,

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